

## REMARKS

1           The Examiner objected to the drawings under 37 C.F.R. 1.83(a) for failing to  
show every feature of the invention specified in the claims. Specifically, the Examiner  
states that the "tube having an arcuate portion" must be shown. Accordingly, applicant  
5           submits Figure 5 herewith that clearly demonstrates the arcuate portion. Amendments  
have been made to the specification in accordance with Figure 5. Accordingly, the  
drawings are believed to be in an allowable condition.

          The Examiner rejected claim 8 under 35 U.S.C. § 102(b) as being anticipated by  
Bilweis (5,196,003). Specifically, the Examiner states that Bilweis teaches a tool having  
10           an elongated tube with a sleeve 20 that is slidably coupled to the outer surface of the  
elongated tube and is further provided with a sealing surface 24 at its distal end.  
Applicant respectfully disagrees. Bilweis specifically teaches that the proximal end 24  
of the cannula is rounded to avoid the suction cup 13 from injuring the tissues or organs  
15           it takes hold of. Accordingly, the rounded proximal end 24 is not taught as providing a  
sealing surface at all. Rather, the suction cup 13 at the proximal end of the tube  
provides a sealing engagement with the organs that the tool comes into contact with.  
Therefore, Bilweis does not teach or otherwise disclose a distal end portion of the  
sleeve that has a sealing surface that can be selectively positioned to seal a bone  
20           cavity, as specifically claimed in claim 8. Accordingly, claim 8 is believed to be  
allowable, since a claim is anticipated only if each and every element as set forth in the  
claim is found, either expressly or inherently described, in a single prior art reference.  
Verdegaal, Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051,

1053 (Fed. Cir. 1987). There is no teaching or suggestion that the rounded surface 24  
1 of the Bilweis tool could seal a bone cavity.

The Examiner has rejected claims 1, 3 and 4 under 35 U.S.C. § 103(a) as being  
unpatentable over Kelman (5,417,654) in view of Dubinsky (WO 99/52441).  
5 Specifically, the Examiner states that Kelman teaches the tool as claimed but does not  
disclose a gasket operatively coupled to the distal end of the sleeve. The Examiner  
states that Dubinsky teaches a tool with a sleeve having a gasket operatively coupled  
thereon. Applicant has amended claim 1 to specifically state that the gasket is  
positioned to be slidably coupled with the tube so that a seal is established between the  
10 distal end of the sleeve and the tube. This is important to the second part of the  
limitation, which was previously added, stating that the gasket is shaped and sized for  
selective sealing engagement with the coracoid process. Without a seal being  
established between the sleeve and the tube, the tool could not be placed in a sealing  
15 engagement with the coracoid process for generating the required suction. The  
Dubinsky gasket 132 is provided in the form of pads extending outwardly from the outer  
surface of the "sleeve" of the tool. At no point does the gasket 132 come into sliding  
contact with the two, let alone create a seal therewith. Accordingly, claim 1 is believed  
to be patentably distinct from the prior art. The Examiner is respectfully requested to  
20 reconsider the aforementioned rejection and allow claim 1.

Claims 3 and 4 each depend from amended claim 1 and are believed to be  
allowable for at least the reasons set forth hereinabove with respect to claim 1.


1 Accordingly, the Examiner is respectfully requested to reconsider the rejections of  
claims 3 and 4 and allow the same.

5 The Examiner has rejected claims 2 and 5 under 35 U.S.C. § 103(a) as being  
unpatentable over Kelman in view of Dubinsky and further in view of Lee et al.  
(5,693,030). Specifically, the Examiner states that Kelman and Dubinsky teach the tool  
as claimed by claim 1 and Lee teaches a tube with a distal portion having a plurality of  
openings as well as an obturator that may be extended into the tube for clearing debris.  
Claims 2 and 5 each depend from claim 1 and are believed to be allowable for at least  
the reasons set forth hereinabove with respect to claim 1. Accordingly, the Examiner is  
10 respectfully requested to reconsider the aforementioned rejections and to allow claims 2  
and 5.

15 In light of the above amendments and remarks, applicant asserts that the claims  
are in condition for allowance. Applicant respectfully requests reconsideration and  
allowance of the same.

No fees or extensions of time are believed to be due in connection with this  
amendment; however, please consider this a request for any extension inadvertently  
omitted, and charge any additional fees to Deposit Account No. 502093.

20 Respectfully submitted,



SHANE M. NIEBERGALL  
Registration No. 44,974  
THOMTE, MAZOUR & NIEBERGALL  
Attorneys of Record



2120 South 72nd Street, Suite 1111  
Omaha, NE 68124  
(402) 392-2280

**CERTIFICATE OF MAILING**

I hereby certify that the original of this AMENDMENT for R. MICHAEL GROSS, Serial No. 10/046,592, was mailed by first class mail, postage prepaid, to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 10<sup>th</sup> day of September, 2004.

  
SHANE M. NIEBERGALL